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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,038	03/25/2002	Murat Acemoglu	4-31153A	9567

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THOMAS HOXIE
NOVARTIS, CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 430/2
EAST HANOVER, NJ 07936-1080

EXAMINER

SHIPPEN, MICHAEL L

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 01/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)	
10/089,038	ACEMOGLU ET AL.	
Examiner	Art Unit	
MICHAEL L. SHIPPEN	1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7 is/are rejected.
- 7) ☒ Claim(s) 3-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 08-02-2002. 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Group II in the paper of December 1, 2003 is acknowledged.

Claim Objections

Claims 3-6 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can refer to more than one claim in the alternative only. See MPEP § 608.01(n). Accordingly, the claims 3-6 have not been further treated on the merits.

Claim Rejections - 35 USC § 112¹

Claim 1 is rejected under 35 USC 112, second paragraph, as failing to particularly point out the claimed invention. The "if desired" phrases render the claims

¹ The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in this Office action:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

A claim in multiple dependent form shall contain a reference, in the alternative only, to more than one claim previously set forth and then specify a further limitation of the subject matter claimed. A multiple dependent claim shall not serve as a basis for any other multiple dependent claim. A multiple dependent claim shall be construed to incorporate by reference all the limitations of the particular claim in relation to which it is being considered.

indefinite. It is unclear if this requires some kind of mental step. If one carries out the recited process steps without the requisite desire, would this be outside the purview of the claims? The phrase "compound of[sic] the invention" is ambiguous since there is no indication what compound is the invention.

Claim Rejections - Improper Markush

Claim 2 is rejected under case law as being drawn to an improper Markush grouping of process. The claim contains an improper Markush group which does not meet the unity of invention test defined in *In re Harnisch*, 206 USPQ 300. Also see *Ex parte Mayne*, 59 USPQ 342. There is no apparent unity of the all of the processes as set forth in the claim. It appears to be a collection of single steps in unidentified overall processes. If any of the separate steps have unity with another step, it is not apparent from the manner the steps are set forth in the claims. It is suggested that the separate steps and/or combination of related steps be presented in separate claims.

Claim 7 is rejected under case law as being drawn to an improper Markush grouping of compounds. *Ex parte Markush*, 1925 C.D. 126; 340 O.G. 839, sanctions, in chemical cases, claiming a genus expressed as a group consisting of certain specified materials. This type of claim is employed when there is no commonly accepted generic expression which is commensurate in scope with the field which the applicant desires to cover, see *Ex parte Head*, 214 USPQ 551; *In re Gaubert*, 187 USPQ 664 and *In re Harnisch, supra*. However, the members set forth in the Markush group do not belong to a recognized chemical class or to an art-recognized class. There is no common structure in all the compounds claimed. They do not possess common use the have

separate uses in distinct processes. It is suggested that the distinct intermediates be presented in separate claims.

Claim Rejections - 35 USC § 103²

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/11605 and USP 3,558,690. The prior art generically teaches the claimed process, note process (c) of page 13 of WO 99/11605 and column 5 of USP 3,558,690. Moreover, the reference exemplifies processes using very similar reactants affording structurally similar products, note Example 38 of WO 99/11605 and Example 1 of USP 3,558,690. It is well within the skill of the artisan to operate within the parameters suggested by the disclosure of the reference and carry out the prior art process with the expectation that one will obtain the results taught in the reference. The claimed reactants are quite analogous to the reactants exemplified in the reference. The differences in the reactants are found only in substituents that are removed from the reaction site and do not affect the outcome of the reaction. The reactive functional groups involved are the same and undergo the same conversion. The claimed process affords the products one would expect from the teaching of the prior art. The use of a new starting material in an otherwise old process is considered obvious. One would be

² The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

motivated to prepare such products since such products are admittedly well known useful products. Moreover, WO 99/11605 clearly shows that species within the genus of the product are in fact known useful products, note for example, the compounds listed in Table 1 of the reference.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO 99/11605 and USP 3,558,690. The references generically teach the claimed compounds, note compounds of Formula III(A) and their intermediates of USP 3,558,690 and the compounds of Formulae (VII), (VIII) and (IX) of WO 99/11605. The references do not specifically exemplify the instant compound. However, the generic teaching indicates to one of ordinary skill in the art that species falling within the generic disclosure, including the instantly claimed compounds, would possess the prior art use. It is well within the skill of the artisan to select among the alternatives of the reference to afford compounds possessing the prior art use, *In re Lemin*, 141 USPQ 814. The references disclose homologues of the instantly claimed compounds, note Example 38 of WO 99/11605. Homologues are a class of compounds differing only by a methylene linkage and possessing similar structures. Compounds of a homologous series are recognized as possessing a community of properties in common. Accordingly, it would have been obvious to one of ordinary skill in the art the interchange of these homologous substituents in the prior art compound would afford closely related structures and compounds possessing similar properties.


Conclusion

The remaining references are cited as of interest.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(703) 308-4635**. The Examiner's normal tour of duty is 7:30 AM to 4:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1235**. The official group FAX machine number is **703-872-9306**.

MShippen
December 29, 2003



MICHAEL L. SHIPPEN
PRIMARY EXAMINER
ART UNIT 1621